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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,297	12/19/2000	David L. Hecht	07447.0006	3320

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EXAMINER

KIM, CHONG R

ART UNIT PAPER NUMBER

2623

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,297

Applicant(s)

HECHT ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment and Arguments

1. Applicant's amendment filed on January 30, 2004 has been entered and made of record.
2. In view of applicant's amendment, the claim objections are withdrawn.
3. Applicant's arguments have been fully considered, but they are not deemed to be persuasive for at least the following reasons.

Applicants argue (page 6) that their claimed invention (claim 1) differs from the prior art because "Mowry does not appear to teach periodic tiles...Nor does Mowry teach a predefined occlusion area on each tile". The Examiner disagrees. Mowry illustrates the periodic tiles in figure 7. Note that a "tile" can be defined as an 8x8 array, 10x10 array, 16x16 array, or any size array of glyphs. Furthermore, Mowry discloses a predefined occlusion area such as "VOID" on each tile (see figure 7).

Applicants further argue (page 6) that "there is simply no teaching (in Mowry) of the same occlusion area embedded on each tile". The Examiner responds by pointing out that claim 1 does not recite that the same occlusion area is embedded on each tile. Claim 1 recites "a predefined occlusion area not necessary for decoding the code pattern". In this case, Mowry discloses a predefined occlusion area (VOID) that is not necessary for decoding the code pattern (col. 9, line 59-col. 10, line 36).

In response to applicant's argument (page 7) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

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teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hecht and Mowry are combinable because they are both concerned with security documents containing periodically tiled glyphs. Mowry improves the security of the document by utilizing two distinct security features (Mowry, col. 4, lines 63-64). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the predefined occlusion area of Mowry in the tile of Hecht. The suggestion/motivation for doing so would have been improve the security of the document (substrate).

Applicants further argue (page 8) that their claimed invention (claim 3) differs from the prior art because “the example provided in the office action does not teach having a code pattern common to the other tiles in a predefined code area, and a second code pattern in the predefined occlusion area”. The Examiner disagrees. As noted in the previous office action (pages 5-6), Hecht discloses a code pattern common to the other tiles in a predefined code area in col. 6, lines 12-29 and figure 6, and Mowry discloses a second code pattern in a predefined occlusion area in col. 9, line 59-col. 10, line 36 and figure 7. Therefore, the combination of Hecht and Mowry appear to still be applicable to claim 3.

Applicants further argue (page 9) that their claimed invention (claim 6) differs from the prior art because the applicant’s claimed “occlusion area for each of the multiple tiles must be the same (the content of the occlusion area can be different, but the same portion of each tile is used as the occlusion area)”. As noted above, the claim language does not recite that the occlusion area for each of the multiple tiles must be the same.

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Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/737,869. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application covers equivalent subject matter and is merely a broader recitation of claim 1 of the copending application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hecht et al., U.S. Patent No. 6,000,621 ("Hecht") and Mowry, Jr., U.S. Patent No. 5,951,055 ("Mowry").

Referring to claim 1 as best understood, Hecht discloses an embedded data code on a substrate, comprising:

a. periodic tiles, each comprising a predefined code area (51) having a code pattern common to other tiles (col. 6, lines 12-29 and figure 6).

Hecht fails to disclose a predefined occlusion area not necessary for decoding the code pattern. However, this feature was exceedingly well known in the art. For example, Mowry discloses periodic tiles comprising a predefined occlusion area not necessary for decoding a code pattern (col. 9, line 59-col. 10, line 36 and figure 7. Note that the security image "VOID" is interpreted as the predefined occlusion area).

Hecht and Mowry are both concerned with security documents containing periodically tiled glyphs. Mowry provides an improved security document by utilizing two distinct security features (Mowry, col. 4, lines 63-64). Therefore, it would have been obvious to include the predefined occlusion area of Mowry in the tile of Hecht, in order to improve the security of the document (substrate).

Referring to claim 2, Hecht further discloses that each tile comprises glyphs (col. 6, lines 12-18).

Referring to claim 3, Mowry further discloses that the occlusion comprises a second code pattern [figure 7. Mowry explains that the occlusion (security image "VOID" 70) is composed

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of a code pattern (72) that is different from the code pattern (68) of a predefined code area (66), see col. 7, lines 15-37 and figure 3].

Referring to claim 4, Mowry further discloses that the occlusion comprises a graphic (col. 10, lines 27-36 and figure 7. Note that the security image "VOID" is interpreted as a graphic).

Referring to claim 5, Mowry further discloses that the occlusion comprises text (col. 10, lines 27-36 and figure 7).

Referring to claim 6, Mowry discloses multiple occlusions within the periodic tiles (figure 7), but fails to disclose that there are multiple occlusions within a tile. However, the Examiner notes that the number of occlusions within a single tile of Mowry would have depended on the specific location of the tile in the document. For example, it appears that in figure 7, a tile located near the center of the document would include multiple occlusions ("VOID" and "PAY ONLY"). Therefore, it would have been obvious to include multiple occlusions within a tile of Mowry, since the multiple occlusions (enhanced security data) improves the security of the document (col. 10, line 6-36).

Referring to claim 7, Mowry further discloses that the occlusions are contiguous for occlusion strips spanning across tile boundaries (figure 7. Note that the occlusion strips "NOT VALID OVER FIVE HUNDRED U.S. DOLLARS" spans across tile boundaries).

Referring to claim 8, Mowry further discloses that the occlusion strips contain printing across tile boundaries [figure 7. Note that the occlusion strips "NOT VALID OVER FIVE HUNDRED U.S. DOLLARS" contain printing (text) across tile boundaries].

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ck

April 9, 2004


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